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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,787	09/04/2001	Dietmar Huglin	HP/2-21867	3542
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JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591			EXAMINER CHANNAVAJALA, LAKSHMI SARADA	
			ART UNIT	PAPER NUMBER
			1611	
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			07/08/2009 ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

09/830,787

**Applicant(s)**

HUGLIN ET AL.

**Examiner**

Lakshmi S. Channavajjala

**Art Unit**

1611

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 33, 35, 36, 42, 43, 47 and 48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33, 35, 36, 42, 43, 47 and 48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Receipt of remarks dated 4-9-09 is acknowledged.

Claims 33, 35, 36, 42, 43 and 47-48 are pending in the instant application.

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4-9-09 has been entered.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 33, 35, 36, 42, 43, 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,643,985 to Hoffmann et al (Hoffmann) in view of US 5,242,689 to Yoshihara et al and US 6042839 to Lahanas et al (Lahanas)

Hoffmann teaches stabilization and prevention of oxidation of plastic materials of household or industrial type by the addition of phenolic antioxidants (col.1). The compounds (benzenepropanoic acid 3-(1,1-dimethylethyl)-4-hydroxy)-5-methyl-1,2-ethandiylbis(oxy-2,1-ethandiyl)ester & benzenepropanoic acid 3,5-bis-(1,1-dimethylethyl)-4-hydroxy)-1,6-hexanedylester) described in col. 6 of the Hoffmann meet the claimed compounds with the conditions of "e=2, Q= ethylene, v is O (for claims 33,

35, 36, 42-43). Hoffmann teaches mixtures of the compounds (see col. 3). While Hoffmann teaches the stabilizing compounds for recycled plastic materials (domestic as well as industrial- see col. 12 for lubricants, antistatic agents, pigments) and not body-care products, instant claims recite "body-care products". However, Hoffmann teaches the antioxidants for stabilizing recycled plastic materials that mainly comprise of polymers such as polystyrene, polyolefin etc (col. 1, L 18-25),

Yoshihara teaches cosmetic compositions comprising powdery organic substances such as polyethylene, polypropylene, polyvinyl chloride etc (col. 2, L 37-60, claim 2) and further suggests that the compositions further contains additives such as antioxidants (col. 3, L 41-53). Yoshihara does not teach how to incorporate the antioxidants in the compositions.

Lahanas teach cosmetic powder compositions with water soluble gum and clay crosslinked with metal cation. Lahanas teaches that examples of cosmetic powders include polystyrene, kaolin etc (col. 1, 18-21; col. 2, L 66-67) and usually undergo oxidation with other materials such as biological materials that renders them unfavorable in cosmetic compositions. Lahanas teaches including the conventional cosmetic materials such as claimed in the instant application (col. 3). The preparation of the cosmetic compositions in Lahanas include solubilizing or suspending in water or aqueous and alcohol (col. 3, L 60-68 and examples).

It would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to employ the antioxidant phenolic compounds of Hoffmann to stabilize cosmetic compositions containing polymeric materials such as polyethylene,

polypropylene, polyvinyl chloride of Yoshihara or Lahanas because Hoffmann suggests that the antioxidant compounds are effective in stabilizing the polymeric materials of plastic against thermoxidative degradation and both Yoshihara and Lahanas include polystyrene materials as cosmetic powders in the various cosmetic materials such as those claimed. A skilled artisan would have expected a stable cosmetic powder composition due to the presence of the antioxidants of Hoffmann. Further, including the antioxidants in the form of aqueous solutions or suspensions or oil soluble components depending on the other constituents of the compositions would have been within the scope of a skilled artisan so as to achieve the desired antioxidant effect upon solubilizing or suspending. Accordingly, a skilled artisan would be motivated to include the antioxidant of Hoffmann in a phase (aqueous or alcoholic or oil) in which the polystyrene pigments of Lahanas (or Yoshihara) are present so as to achieve the desired antioxidant effect.

3. Claims 33, 35 and 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable US 5,723,435 to Severns et al (Severns) in view of US 5,719,129 to Andary et al (Andary).

Severns states that the above antioxidant compounds demonstrate light stability and generally protect dyes from degradation by first preventing generation of singlet oxygen and peroxy radicals, thereafter terminating the degradation pathway (col. 4, L 43-53). In addition to the fabric care compounds such as fabric softeners, Severns also

teaches incorporating sunscreen agents such as those described in col. 11 in the compositions containing above antioxidants (the examples include Tinuvin 328, which is UV absorbing compound). All of the examples of Severns teach preparing the compositions with water and hence reads instant aqueous phase. Severns does not teach body care compositions.

Andary teaches caffeic acid derivatives in cosmetic and dermatological compositions for effective antioxidant effect and anti-inflammatory effect. Andary teaches that exposing to UV radiation; oxygen reduction is incomplete and results in the formation of free radicals that deteriorates phospholipids in cell membranes, resulting in various conditions such as aging, carcinogenesis etc (col. 3, L 25-36). Andary suggests incorporating a caffeic acid derivative, oraposide, for trapping free radicals, and providing protection from UV A and UVB radiation (col. 3, 1-17). The example formulation in col. 10 of Andary shows that the antioxidant is added in aqueous phase. Thus, employing antioxidant compounds with sunscreen and free radical inhibiting effects are known in the art. Accordingly, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to employ the antioxidant phenolic compounds of Severns for their antioxidant activity not only in fabric softening compositions but also in cosmetic or pharmaceutical skin care composition such as Andaray because Andaray suggests antioxidant compounds provide free radical inhibition and protect from ultraviolet radiation in sunlight (sunscreen). A skilled artisan would have expected the antioxidant compounds of Severns that also posses light stability to protect the skin from deterioration of phospholipids in cell

membranes and thus inhibit various conditions such as aging, carcinogenesis etc. Further, employing the antioxidants compounds of Severns in an appropriate phase i.e., water or oil phase as appropriate depending on the desired solubility of the antioxidant would have been within the scope of a skilled artisan.

***Response to Arguments***

Applicant's arguments filed 4-9-09 have been fully considered but they are not persuasive.

Applicants state that the phenolic antioxidants of Hoffmann have some overlap with those of the present claims. However they argue that the Examiner asserts that it would have been obvious to employ the antioxidant phenolic compounds of Hoffmann to stabilize the cosmetic compositions of Yoshihara, which constitutes hindsight analysis. It is argued that as demonstrated by the working Examples of Hoffmann, the additives therein are intimately mixed with the recycle via melt processing, that is melt extrusion or melts mixing. Yoshihara is totally silent as how to incorporate optional additives. It is argued that In view of the combined teachings of Hoffmann and Yoshihara, Applicants submit that one skilled in the art would be motivated to stabilize the thermoplastic polymer via melt mixing of the antioxidant with the polymer. One would not be motivated to incorporate antioxidants into the mobile phase of a cosmetic formulation.

Applicants argue that Severns is cited as teaching the stabilization of fabric care compositions with antioxidants. Applicants submit that this to combine these two

references is hindsight analysis that Severns and Andary are aimed at disparate arts and are not properly combined. It is argued that the antioxidants of Andary are clearly intended to protect for example skin: "The compositions according to the invention are particularly effective in preventing aging of the skin and in treatment of inflammatory conditions...", col. 3, lines 25-27. The "composition may therefore be , formulated in the form of an injectable dose, or for oral administration or for external treatment by...; topical application", col. 3, lines 18-22. The problem solved with the present invention is the prevention of photooxidation and autooxidation processes in body-care products. The preparation of the body-care products includes dissolution of the antioxidants in an oil phase or alcoholic or water phase. One skilled in the art would not look to these references concerned with protecting fabrics and skin in order to attempt to solve the present problem.

Applicants' arguments are considered but not found persuasive. Firstly, instant claims are now rejected over a combination of Hofmann, Yoshihara and Lahanas and not Hofmann and Yoshihara alone.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA



1971). In the instant situation, employing phenolic antioxidants as stabilizing is known in the prior art. Further, The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1395-97 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in *Graham*. Exemplary rationales that may support a conclusion of obviousness include: combining prior art elements according to known methods to yield predictable results; use of known technique to improve similar devices (methods, or products) in the same way; applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one if the variations are predictable to one of ordinary skill in the art and finally, some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Thus, the teachings of Hoffmann that the phenolic antioxidants may be used to stabilize plastic materials, which are also commonly used in body care products (Yoshihara), would lead one skilled in the art to employ such antioxidants in other compositions containing the thermoplastic materials, including body care products of Yoshihara with a reasonable expectation to stabilize the thermoplastic materials of Yoshihara. Further, instant rejection now includes the teachings of Lahanas that shows incorporating polystyrene powders materials in cosmetic compositions, particularly in appropriate cosmetic phases. Accordingly, a skilled artisan would be motivated to

include the antioxidant of Hoffmann in a phase (aqueous or alcoholic or oil) in which the polystyrene pigments of Lahanas (or Yoshihara) are present so as to achieve the desired antioxidant effect.

Similarly, a skilled artisan would have reasonably expected that the phenolic compounds of Severns to exhibit their antioxidant activity not only in fabric softening compositions but also in cosmetic or pharmaceutical skin care composition such as Andaray because Andaray suggests antioxidant compounds provide free radical inhibition and protect from ultraviolet radiation in sunlight (sunscreen). Andary also teaches preparing the antioxidant materials in aqueous phase (examples).

Therefore, choosing an appropriate aqueous or alcoholic or oil phase for the antioxidant of Hoffman or Severns, depending on the final composition being prepared and the desired solubility of the composition would have been within the scope of a skilled artisan. Andary not only teaches oral but also clearly teaches cosmetic composition such as skin lightening composition, gel composition etc. There applicants' arguments with respect to Andary and Severns are not persuasive.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lakshmi S Channavajjala/  
Primary Examiner, Art Unit 1611  
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